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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,328	01/14/2002	Hidekazu Yano	Q68052	6686

7590 09/07/2005
SUGHRUE, MION, ZINN MACPEAK & SEAS, PLLC
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EXAMINER

CHOW, MING

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,328

Applicant(s)

YANO ET AL.

Examiner

Ming Chow

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 16, 17, 22, 23, 32 and 33 is/are rejected.
- 7) ☒ Claim(s) 4-7, 18-21 and 23-27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12-29-04</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Applicant's election without traverse of claims 1-9, 16-27, 32, 33 in the reply filed on 6-17-05 is acknowledged.

Information Disclosure Statement

2. The information disclosure statement filed 4-7-04 and 12-29-04 fail to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Allowable Subject Matter

3. Claims 4-7, 18-21, 24-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the

base claim and any intervening claims. The allowable subject matters are “when said user terminal currently is a busy state is detected within a prohibition area, the communication limiter instructs the disconnection processor in the user terminal to disconnect the communication”, “when said user terminal in a busy state is approaching a prohibition area, the communication limiter notifies the user terminal of the approaching fact and the disconnection processor issuing an alarm urging the user to disconnect”, “when the user terminal originates a call within a prohibition area to another terminal, the communication limiter notifies either the called party or the caller that the other party is within a prohibition area”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 16, 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Havinis et al (US: 6463289).

Havinis et al teach on items 270, 14, Fig. 2, SMLC and MSC/VLR (together is the claimed “a communication limiter”). Havinis et al teach on column 3 line 45-46, SMLC calculates the MS location (claimed “determine a location of said user terminal”). Havinis et al teach on column 5 line 48-52, MSC/VLR determines the location is within a restricted area.

5. Claims 16, 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Andersson et al (US: 6230017).

Andersson et al teach on column 4 line 48-60, HLR stores restriction information for limiting subscriber’s use of mobile station to a specific geographical area.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1-3, 8, 9, 17, 23, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havinis et al (US: 6463289), and in view of Hameleers et al (US: 6377799).

Regarding claim 1, Havinis et al teach on item 20 Fig. 1, a user terminal.

Havinis et al teach on items 270, 14, Fig. 2, SMLC and MSC/VLR (together is the claimed “a communication limiter”). Havinis et al teach on column 3 line 45-46, SMLC calculates the MS location (claimed “determine a location of said user terminal”). Havinis et al teach on column 5 line 48-52, MSC/VLR determines the location is within a restricted area.

Havinis et al failed to teach “limiter transmits disconnect instructions to user terminal when the user terminal is within said prohibition area; and said user terminal comprises a disconnection processor to disconnect communications”. Hameleers et al teach on column 4 line 43-44, MSC/VLR sends a disconnect message to the MS which returns a Release message to the MSC/VLR. The MS must have a processor to send the Release message (claimed “disconnection”).

It would have been obvious to one skilled at the time the invention was made to modify Havinis et al to have the “limiter transmits disconnect instructions to user terminal when the user terminal is within said prohibition area; and said user terminal comprises a disconnection processor to disconnect communications” as taught by Hameleers et al such that the modified system of Havinis et al would be able to support the system users conveniences of performing disconnections.

Regarding claims 2, 8, Havinis et al teach on column 3 line 39, GPS.

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Havinis et al teach on column 3 line 46, returns the location to the MSC/VLR (claimed “means for notifying said communications limiter of data about the current location”).

Regarding claims 3, 17, 23, Havinis et al teach on column 5 line 47-48, restricted area information is stored in the MSC/VLR (claimed “use prohibition area registration table”). The VLR is also the claimed “a location information management table for recording a current location”.

The SMLC and MSC/VLR (claimed “terminal location manager”) of Havinis et al (see rejections as stated in claim 1) detect the user terminal within the prohibition area and control the user terminal does not communication within the prohibition area.

Regarding claim 9, Havinis et al teach on column 3 line 23-24, HLR is integrated with the VLR.

Regarding claim 33, Havinis et al teach on Fig. 2, the SMLC and MSC/VLR (claimed limiter”) are external to the user terminal.

7. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Havinis et al, and in view of Hameleers et al.

The modified system of Havinis et al in view of Hameleers et al as stated in claim 1 above failed to teach “the prohibition area comprises a hospital”. However, the area where is defined as a prohibition area is “Design Choice”.

It would have been obvious to one skilled at the time the invention was made to modify Havinis et al in view of Hameleers et al to have the “the prohibition area comprises a hospital” such that the modified system of Havinis et al in view of Hameleers et al would be able to support the system users conveniences of defining a hospital as prohibition area.

Response to Arguments

8. Applicant's arguments filed on 6/17/05 have been fully considered but they are not persuasive.

- i) Applicant argues, on page 12, regarding objections to IDS. The Examiner did not receive the English translation of the corresponding documents.
- ii) New grounds rejections necessitated by the amendments have been stated above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (571) 272-7535. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (571) 272-2600. Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks


Washington, D.C. 20231

Or faxed to Central FAX Number 571-273-8300.

Patent Examiner

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Ming Chow



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SUPERVISORY PATENT EXAMINER
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